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SIDNEY YOUNG, COURT REPORTER, 418 FEDERAL BLDG., SHREVEPORT, LA.

Mailed May 22, 1952

EXAMINER'S STATEMENT

This is an appeal from the final rejection of claims 1, 2 and 3.

Claims 23, 24, 27, 28 and 29 have been allowed.

A correct copy of the appealed claims appears on pages 1 and 2 of the applicant's brief.

The reference relied upon is:

Blanchard 2,199,611 May 7, 1940

The applicant's device is adequately described, for purpose of this appeal, on pages 2 3 and 4 of his brief.

Claims 1, 2 and 3 stand rejected on the ground of double patenting. These claims define nothing patentable over the claims in applicant's patent No. 2,199,611. It is conceded by applicant that broad claims 1, 2 and 3 herein are met by the structure recited in the specific claims in the patent. It is believed clear that the issuance of species claims in the patent in 1940 bars the issuance now of generic claims 1, 2 and 3. Applicant contends that the presentation of a generic claim in his original application 44,988 filed in 1935 gives him the right to have generic claims now. However, the generic claim on which he relies (Claim 15 of application 44,988) was not to the same subject matter as the present claims 1, 2 and 3 since it was drawn to a combination including fluid motor actuated main valves and was not drawn to the float operated valves per se as are the claims at bar.

Regardless of the subject matter of claim 15 of original application

44,988 the important point to note is that such claim 15 was cancelled April 6, 1940 (page 8 of applicant's brief and patent file of patent No. 2,233,395) prior to his filing on February 20, 1941 of application Serial No. 379,822 which contained claims 8, 9 and 10, which correspond to claims 1, 2 and 3 now at bar.

Thus at the time (February 20, 1941) when generic claims 8, 9 and 10 in Serial No. 379,822 were first presented applicant did not have pending in any application a generic claim of any kind, i.e. combination or element claim, and the species claims relied upon in this double patenting rejection had already issued on May 7, 1940. To state the situation in different words. the species claims in the patent relied upon were permitted to issue May 7, 1940 during the hiatus between the cancellation (in Serial No. 44,988, Patent file 2,233,395) of the generic combination claim 15 on April 6. 1940 and the presentation (in Serial No. 379,822 patent file 2,395,212) of generic element claims 8, 9 and 10 on February 20, 1941.

In view of the foregoing, it seems clear that applicant is not now entitled to these generic claims. See Kaplan v. Robertson 9 U.S.P.Q. 563; 50 Fed. (2) 617 and Union Typewriter Co. v. Smith 173 Fed. 288 which are believed to hold that generic claims to the same subject matter must be filed before the species claims issue and that the generic claims must be continuously prosecuted. See also Ex parte Gump 83 U.S.P.Q. 351 which appears to hold that an applicant is not entitled to generic claims after the issuance of specific claims, whether or not he continuously asserted generic claims in his parent cases.

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Acting Examiner.

Mailed Nov. 28, 1952

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Alva G. Blanchard

application for Patent filed March 7, 1945, Serial No. 581,373.

Automatic Control Mechanism for Pressure Vessels.

Hamer H. Jamieson for appellant.

This is an appeal from the final rejection of claims 1, 2 and 3.

Claim 1 is illustrative and reads as follows:

> 1. A float chamber, a plurality of fluid passages through the wall thereof, valves in said passages, a float arm privoted adjacent to said passages, a float thereon, and means on the pivoted end of said float arm whereby said fluid passages may be opened in a predetermined order by the fall of said float.

The reference relied upon is:

Blanchard	2,199,611	May 7, 1940

The application is concerned with the sequential control of a multiple valve, the details of which are considered sufficiently set forth on pages 2 and 3 of appellant's brief.

The claims stand rejected on the ground of double patenting in view of appellant's patent 2,199,611.

In reviewing the chronological background of the instant application, it is noted that it stems from an application filed October 14, 1935.

Division was required in this application, and on May 28, 1938 the divisional application resulting in the Blanchard patent 2,199,611, granted May 7, 1940, was filed. The prosecution of the parent continued to appeal, terminating adversely to appellant except as to one claim. Appellant on April 6, 1940 cancelled all claims except the single claim which had been allowed, whereupon the application was in due course passed for issue. On December 5, 1940, delay of issue was requested in order to permit appellant time to file a "partial division" application. Said application was filed as a continuation-in-part on February 20, 1941. In this application division was also required, and on March 7, 1945 the instant application was filed as a result of said requirement.

There appears to be no controversy that the claims here on appeal correspond to claims 8, 9 and 10 of the application filed February 20, 1941. However, it is the Examiner's position that at the time these claims "were first presented applicant did not have pending in any application a generic claim of any kind, i. e. combination or element claim, and the species claims relied upon in this double patenting rejection had already issued on May 7, 1940." Appellant contends that he has attempted to obtain broad generic claims to his "valve construction from the date of first filing Serial No. 44,988 on October 14, 1935" some seventeen years ago. In this connection, he calls attention to claim 15 of said application and contends that this claim covers "the broad generic invention, although covering it in combination with other elements of the system" and

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> "there is no rule of law known to appellant which requires that he claim the generic subject matter in the same form or type of claims in all of his applications in order to avoid questions of double patenting."

We do not believe that in the instant case it is a matter of form or type but a matter of substance of the claims. We do not consider this claim 15, which admittedly contains elements of the system not present in the claims here on appeal, is sufficient to avoid the rejection of double patenting.

We are not unmindful that said claim 15 was rejected on the ground of old combination and the rejection sustained on appeal. However, the fact remains that this claim was not drawn to the same combination as the claims here on appeal and that the latter claims were not presented until more than nine months after the Blanchard patent 2,199,611 issued.

A careful consideration of the law cited by appellant and especially Kaplan v. Robertson, 50 F. (2d) 617, which appears to be directly in point, leads us to the conclusion that the Examiner's position is sound.

We have carefully considered all of the contentions and arguments in appellant's brief, as well as those presented at the hearing, but we are not convinced thereby that there was reversible error in the rejection of the appealed claims.

The decision of the Primary Examiner is affirmed.

H. H. Jacobs
Examiner-in-Chief

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B. H. Carpenter
Examiner-in-Chief
(Acting)

L. M. Andrus
Examiner-in-Chief
(Acting)

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SIDNEY YOUNG, COURT REPORTER, 418 FEDERAL BLDG., SHREVEPORT, LA.

MEMORANDUM OF COURT

Morris, J. This is a proceeding under Title 35, Section 145, U. S. C. (formerly Section 4915, Revised Statutes), for a determination that a patent should issue on claims 1, 2 and 3 in plaintiff's application for a patent, Serial Number 581,373, filed March 7, 1945, for apparatus in connection with the operation of valves in outlets for steam boilers. The defendant asserts that a patent on such claims should not issue in that they are not patentable over Patent No. 2,199,611, issued May 7, 1940 to the plaintiff and, therefore, would constitute double patenting. The defendant also asserts that the claims here involved are not patentable over Patent No. 683,021, issued to Clark, et al. (1901), No. 458,794, issued to McLaughlin (1891), and Patent No. 7,767, issued to Singleton (1877). These last three references were not cited in the Patent Office, but are asserted as authorized by the case of American Steel and Wire Company of New Jersey v. Coe, 70 App. D. C. 138, 105 F. (2d) 17.

There can be no serious question that the claims here involved are generic claims, of which the claims in Patent No. 2,199,611 are specie claims. It is urged, however, by plaintiff that the three claims here involved are substantially the same generic claims as claim No. 15 in his application, Serial Number 44,988, filed October 14, 1935, upon which Patent No. 2,233,395, issued to Plaintiff March 4, 1941, on certain other claims. Pending final action on that application, plaintiff, on April 6, 1940, when it became subject of an amendment to the application, cancelled all claims, except claim 14, stating that "applicant reserves

the right to amend the cancelled claims and make them the subject matter of divisional applications." On February 20, 1941, plaintiff filed an application, Serial Number 379,822, which was co-pending with his application, Serial Number 581,373, from March 7, 1945 until it issued as Patent No. 2,395,212 on February 19, 1946, in which were included claims 8, 9 and 10 that are in substance claims 1, 2 and 3 in the instant suit. It will thus be seen that from the date of the cancellation of claim No. 15, which the plaintiff insists is the progenitor of his present claims, there was no assertion by the plaintiff of generic claims 8, 9 and 10, which are asserted to be progenitors of the instant claims until February 20, 1941, although patent on the specie claims had issued after the cancellation May 7, 1940 and prior to the reassertion of the generic claims similar to the ones here involved.

The law seems to be well settled that no patent on an application with generic claims may issue subsequent to the grant of a patent on claims to one of the included species, unless the generic claims be introduced into the application prior to the issuance of the species patent. The contention of the plaintiff is that his reservation of an intention to amend the cancelled claims and make them the subject of divisional applications kept such claims alive notwithstanding such cancellation.

Rule 44 of the Patent Office provides:

> "A reservation for a future application of subject disclosed, but not claimed, in a pending application will not be permitted in the pending application."

The plaintiff contends that this rule has no application to subject

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matter which is not only disclosed, but which is claimed, but he loses sight of the fact that, after cancellation of the claim, the subject matter was disclosed and not claimed, and indeed it was not claimed until after the species patent issued. In this situation, it is clear that a patent cannot now be issued on such generic claims.

The plaintiff insists that the claims here involved are patentable over the three references cited, in addition to his own patent, constituting the prior art in that the claims here involved include elements not present in each of the references cited. It seems, however, that such patents do have elements which perform the functions of the elements in plaintiff's claims, and do preclude the issuance of patents on such claims.

For the reasons stated, the relief sought by the plaintiff cannot be granted. Counsel will prepare and submit appropriate findings and order to carry this decision into effect.

J. W. Morris
Judge

July 22, 1955

Filed August 22, 1955

JUDGMENT

This action came on to be heard, and thereupon upon consideration thereof, it is this 18th day of Aug., 1955 ADJUDGED that the complaint be and it is hereby dismissed on the merits, with costs against plaintiff.

J. W. Morris
Judge

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UNITED STATES COURT OF APPEALS

For the District of Columbia

No. 13,006

Alva G. Blanchard, Appellant

v.

Robert C. Watson, Commissioner of Patents, Appellee

Appeal from the United States District Court

for the District of Columbia

Decided May 31, 1956

Mr. Alva G. Blanchard, appellant, pro se.

Mr. Clarence W. Moore, Solicitor, United States Patent Office, for appellee.

Before Edgerton, Chief Judge, and Bastian and Burger, Circuit Judges.

PerCuriam: The judgment of the District Court is affirmed on the opinion of Judge Morris in the District Court. Blanchard v. Watson, 132 Fed. Supp. 744.

Affirmed.

SIDNEY YOUNG, COURT REPORTER, 418 FEDERAL BLDG., SHREVEPORT, LA.